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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/913,976 12/22/97 HODGKINSON

M 71272

EXAMINER

HM22/0615

WELSH & KATZ  
120 SOUTH RIVERSIDE PLAZA  
22ND FLOOR  
CHICAGO IL 60606

PRYOR, A

ART UNIT

PAPER NUMBER

1616

DATE MAILED:

06/15/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

08/913,976

Applicant(s)

Hodgkinson

Examiner

Alton Pryor

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1616



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on Apr 9, 2001

2a) ☐ This action is **FINAL**.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 22, 24-35, and 38-42 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 22, 24-27, 31, 33-35, 38, and 40-42 is/are rejected.

7) ☒ Claim(s) 28-30, 32, and 39 is/are objected to.

8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

20) ☐ Other:

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### **Detailed Action**

- I. Rejection of claim 27 under 35 U.S.C. 102(b) according to Parham on record is maintained in light of amendment filed 4/9/01. The applicant argues that Parham's herbicidal oil does not possess reduced phytotoxicity or show UV deactivation characteristics as the instantly claimed oil. The examiner disagrees with applicant's arguments. Firstly, phytotoxicity as described by the applicants means the killing of plants. However, while it is true that Parham's oil is phytotoxic to weeds or undesirable plants, Parham makes it clear that his composition is not used to kill desirable plants. See Parham's patent page 2 line 17 through page 3 line 6, page 4 lines 29-36. Secondly, with respect to the instant composition showing UV deactivation, there is no patentable weight given to what a composition (oil) does in a claimed drawn to a composition.
- II. Rejection of claims 22,24-26,31,33, and 34 under 35 U.S.C. 103(a) according to NL '602 on record is maintained in light of amendment filed 4/9/01. Applicant argues that NL '602 herbicidal oil does not possess reduced phytotoxicity and that abstract does not teach an overbased calcium sulphonate. Examiner's disagrees with applicant's arguments. Firstly, the reference does not teach the killing of desirable plants by the herbicide oil, but rather the killing of weeds or undesirable plants by the herbicide. Secondly, the applicants do not disclose any data which would suggest that an overbased sulphonate function differently from the prior art sulphonate. The data provided by applicant is merely content descriptions of commercial calcium

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lignin sulphonate products. There is no data comparing the activity of calcium lignin sulphonate with overbased calcium lignin sulphonate in an agricultural application.

III. Rejection of claims 22,24-27,31,33-35,38,40-42 under 35 U.S.C. 103(a) according to Parham and NL '602 in combination is maintained in light of amendment filed 4/9/01. Applicant argues that combining the composition of Parham with the composition of NL '602 would have resulted in a herbicidal oil possessing increased toxicity to plants as opposed to reduced phytotoxicity. The examiner disagrees with applicants for the above reasons. See Examiners responses I and II above.

IV. Objection of Claims 28-30,32, and 39 is maintained in light of amendment filed 9/8/00 for the above reasons and reasons on record.

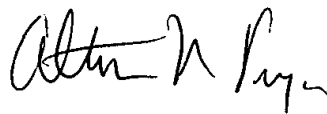
#### ***Telephonic Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton Pryor whose telephone number is (703) 308-4691. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees, can be reached on (703) 308-4628. The fax phone number for this Group is (703) 308-4556.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

A handwritten signature in black ink, appearing to read "Alton W. Pryor". The signature is fluid and cursive, with the first name "Alton" being more prominent.

Alton Pryor

Patent Examiner, AU 1616

6/14/01